

REMARKS

In the first Office Action, the Examiner rejected claims 1-7, 9, 10, 12, 15, and 18-24 under 35 U.S.C. § 102(b) as anticipated by the YAHOO home page (referred to hereinafter as "YAHOO"); rejected claims 8, 13, 14, 17, 25-32, and 37-45 under 35 U.S.C. § 103(a) as unpatentable over YAHOO; rejected claims 11, 16, and 33-36 under 35 U.S.C. § 103(a) as unpatentable over YAHOO in view of LAZARUS et al. (U.S. Patent No. 6,134,532); rejected claims 46-61 under 35 U.S.C. § 102(b) as anticipated by VAN HOFF (U.S. Patent No. 5,822,539); rejected claims 1-10, 12-15, 17-32, and 46-61 under 35 U.S.C. § 103(a) as unpatentable over VAN HOFF in view of YAHOO; and rejected claims 11, 16, and 33-36 under 35 U.S.C. § 103(a) as unpatentable over VAN HOFF in view of YAHOO, and further in view of LAZARUS et al.

By way of the present amendment, Applicants amend claims 1-4, 11, 16, 19-24, 43, 46, 47, 49, 53, and 56-61. Claims 1-61 remain pending.

At the outset, Applicants submit that the YAHOO document is not prior art. The Examiner appears to group a YAHOO search page (page 1 of the YAHOO document) from 1996 with YAHOO search result pages from May of 2004. For example, as is evident from page 2 of the YAHOO document, in response to the search query "state tax rates," YAHOO provided related topics including "2003 state tax rates." Clearly YAHOO did not provide 2003 state tax rates in 1996. As another example, item 9 in the list of search results indicates "1999-2004 Sales Tax Clearinghouse." Clearly, pages 2 and 3 of the YAHOO document post-date Applicants' priority date of December 15, 1999. Applicants submit that pages 2 and 3 of the YAHOO document are NOT prior art and, accordingly, should not be relied upon in a rejection of

Applicants' claims. Any rejection on which the Examiner relied on pages 2 and 3 of the YAHOO document is improper and should be withdrawn.

Claims 1-7, 9, 10, 12, 15, and 18-24 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by YAHOO. Applicants respectfully traverse the rejection with respect to the claims, as now amended.

A proper rejection under 35 U.S.C. § 102 requires that a reference teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. See M.P.E.P. § 2131. YAHOO does not disclose or suggest at least one feature recited in claims 1-7, 9, 10, 12, 15, and 18-24.

For example, independent claim 1 recites a computer-implemented method for performing a search. The method includes obtaining selection of one or more groups of characters in a document currently accessed by a user, where the obtaining includes highlighting the one or more groups of characters in the document and selecting a search object while the one or more groups of characters are highlighted in the document; generating a search query using the selected one or more groups of characters in response to selecting the search object; retrieving search results based on the search query; and presenting the search results to the user. Page 1 of the YAHOO document does not disclose or suggest at least one feature recited in claim 1.

For example, page 1 of the YAHOO document does not disclose or suggest obtaining selection of one or more groups of characters in a document currently accessed by a user, where the obtaining includes highlighting the one or more groups of characters in the document and selecting a search object while the one or more groups of characters are highlighted in the

document. Instead, page 1 of the YAHOO document merely depicts a search page that includes a hierarchical directory listing.

For at least the foregoing reasons, Applicants submit that claim 1 is not anticipated by YAHOO.

Claims 2-7, 9, 10, 12, 15, 18, and 19 depend from claim 1. Therefore, these claims are not anticipated by YAHOO for at least the reasons given above with respect to claim 1.

Amended independent claims 20-24 recite features similar to features recited above with respect to claim 1. Therefore, Applicants submit that these claims are not anticipated by YAHOO for at least reasons similar to reasons given above with respect to claim 1.

Claims 8, 13, 14, 17, 25-32, and 37-45 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over YAHOO. Applicants respectfully traverse.

Claims 8, 13, 14, and 17 depend from claim 1. Therefore, these claims are patentable over YAHOO for at least the reasons given above with respect to claim 1.

Independent claim 25 recites a method for prefetching documents associated with a search. The method includes identifying a document that includes one or more links, where each of the links corresponds to a linked document; analyzing each of the links in the document; determining a score for each of the links; and prefetching a number of the linked documents corresponding to a number of the links based on the determined scores. Page 1 of the YAHOO document does not disclose or suggest at least one feature recited in claim 25.

For example, page 1 of the YAHOO document does not disclose or suggest determining a score for each of the links in the document or prefetching a number of linked documents corresponding to a number of the links based on the determined scores. Instead, page 1 of the

YAHOO document merely depicts a search page that includes a hierarchical directory listing.

For at least the foregoing reasons, Applicants submit that claim 25 is patentable over YAHOO.

Claims 26-32 and 37-41 depend from claim 25. Therefore, these claims are patentable over YAHOO for at least the reasons given above with respect to claim 25.

Independent claims 42-45 recite features similar to features recited in claim 25. Therefore, these claims are patentable over YAHOO for at least reasons similar to reasons given above with respect to claim 25.

Claims 11, 16, and 33-36 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over YAHOO in view of LAZARUS et al. Applicants respectfully traverse.

Claims 11 and 16 depend from claim 1. The disclosure of LAZARUS et al. does not remedy the deficiencies in page 1 of the YAHOO document set forth above with respect to claim 1. Therefore, claims 11 and 16 are patentable over YAHOO and LAZARUS et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 1.

Claims 33-36 depend from claim 25. The disclosure of LAZARUS et al. does not remedy the deficiencies in page 1 of the YAHOO document set forth above with respect to claim 25. Therefore, claims 33-36 are patentable over YAHOO and LAZARUS et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 25.

Claims 46-61 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by VAN HOFF. Applicants respectfully traverse this rejection with respect the claims, as currently

amended.

As set forth above, a proper rejection under 35 U.S.C. § 102 requires that a reference teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. See M.P.E.P. § 2131. VAN HOFF does not disclose or suggest at least one feature recited in claims 46-61.

For example, amended independent claim 46 recites a computer-implemented method for supplementing a document with links to related documents. The method includes analyzing a document to identify one or more pieces of information; determining a link to a related document for each of the identified pieces of information by performing a search of a set of documents based on each of the identified pieces of information; and adding the links to the document. VAN HOFF does not disclose or suggest at least one feature of claim 46.

For example, VAN HOFF does not disclose or suggest determining a link to a related document for each of the identified pieces of information by performing a search of a set of documents based on each of the identified pieces of information. In stark contrast, VAN HOFF merely discloses comparing the characters, words, phrases, and the like in a document with match patterns 195 in a selected annotation directory (col. 7, lines 1-5). VAN HOFF does not disclose or suggest that match patterns 195 in the annotation directory are identified by performing a search of a set of documents based on each of the identified pieces of information, as required by amended claim 46.

For at least the foregoing reasons, Applicants submit that claim 46 is not anticipated by VAN HOFF.

Claims 47-55 depend from claim 46. Therefore, these claims are not anticipated by VAN

HOFF for at least the reasons given above with respect to claim 46.

Amended independent claims 56-61 recite features similar to features recited above with respect to claim 46. Therefore, these claims are not anticipated by VAN HOFF for at least reasons similar to reasons given above with respect to claim 46.

Claims 1-10, 12-15, 17-32, and 46-61 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over HOFF in view of YAHOO. Applicants respectfully traverse.

Claim 1 recites a computer-implemented method for performing a search. The method includes obtaining selection of one or more groups of characters in a document currently accessed by a user, where the obtaining includes highlighting the one or more groups of characters in the document, and selecting a search object while the one or more groups of characters are highlighted in the document; generating a search query using the selected one or more groups of characters in response to selecting the search object; retrieving search results based on the search query; and presenting the search results to the user. VAN HOFF and YAHOO do not disclose or suggest at least one feature recited in claim 1.

For example, VAN HOFF and YAHOO do not disclose or suggest obtaining selection of one or more groups of characters in a document currently accessed by a user, where the obtaining includes highlighting the one or more groups of characters in the document, and selecting a search object while the one or more groups of characters are highlighted in the document. VAN HOFF relates to annotating a document with hypertext links (Abstract). VAN HOFF in no way discloses or suggests the above features of claim 1. Moreover, as set forth above, YAHOO is completely silent with respect to these features.

For at least the foregoing reasons, Applicants submit that claim 1 is patentable over VAN

HOFF and YAHOO, whether taken alone or in any reasonable combination.

Claims 2-10, 12-15, and 17-19 depend from claim 1. Therefore, these claims are patentable over VAN HOFF and YAHOO, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 1.

Amended independent claims 20-24 recite features similar to features recited above with respect to claim 1. Therefore, these claims are patentable over VAN HOFF and YAHOO, whether taken alone or in any reasonable combination, for at least reasons similar to reasons given above with respect to claim 1.

Independent claim 25 recites a method for prefetching documents associated with a search. The method includes identifying a document that includes one or more links, where each of the links corresponds to a linked document; analyzing each of the links in the document; determining a score for each of the links; and prefetching a number of the linked documents corresponding to a number of the links based on the determined scores. VAN HOFF and YAHOO do not disclose or suggest at least one feature recited in claim 25.

For example, VAN HOFF and YAHOO do not disclose or suggest determining a score for each of the links or prefetching a number of the linked documents corresponding to a number of the links based on the determined scores. The Examiner does not address these features in the Office Action (Office Action, pg. 10). Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 25.

VAN HOFF relates to annotating a document with hypertext links (Abstract). VAN HOFF in no way discloses or suggests the above features of claim 25. Moreover, as set forth above, page 1 of YAHOO does not disclose or suggest these features of claim 25.

For at least the foregoing reasons, Applicants submit that claim 25 is patentable over VAN HOFF and YAHOO, whether taken alone or in any reasonable combination.

Claims 26-32 depend from claim 25. Therefore, these claims are patentable over VAN HOFF and YAHOO, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 25.

Amended independent claim 46 recites a computer-implemented method for supplementing a document with links to related documents. The method includes analyzing a document to identify one or more pieces of information; determining a link to a related document for each of the identified pieces of information by performing a search of a set of documents based on each of the one or more of the identified pieces of information; and adding the links to the document. The Examiner did not address the combination of features recited in claim 46 in the rejection based on VAN HOFF and YAHOO (Office Action, pg. 10). Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 46.

The Examiner alleged with respect to the rejection of claim 46 based on VAN HOFF alone that VAN HOFF disclosed all of the features of claim 46. Yet, in this rejection, the Examiner appears to allege that VAN HOFF does not disclose all of the features of claim 46. For at least the reasons set forth above with respect to the rejection based on VAN HOFF alone, Applicants submit that VAN HOFF does not disclose or suggest at least one feature recited in claim 46. Moreover, Applicants submit that page 1 of YAHOO does not remedy the deficiencies in the disclosure of VAN HOFF set forth above with respect to the rejection of claim 46 based on VAN HOFF alone. Therefore, Applicants submit that claim 46 is patentable over VAN HOFF and YAHOO, whether taken alone or in any reasonable combination.

Claims 47-55 depend from claim 46. Therefore, these claims are patentable over VAN HOFF and YAHOO, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 46.

Amended independent claims 56-61 recite features similar to features recited above with respect to claim 46. Therefore, these claims are patentable over VAN HOFF and YAHOO, whether taken alone or in any reasonable combination, for at least reasons similar to reasons given above with respect to claim 46.

Claims 11, 16, and 33-36 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over VAN HOFF in view of YAHOO, and further in view of LAZARUS et al. Applicants respectfully traverse this rejection.

Claims 11 and 16 depend from claim 1. The disclosure of LAZARUS et al. does not remedy the deficiencies in VAN HOFF and YAHOO set forth above with respect to claim 1. Therefore, claims 11 and 16 are patentable over VAN HOFF, YAHOO, and LAZARUS et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 1.

Claims 33-36 depend from claim 25. The disclosure of LAZARUS et al. does not remedy the deficiencies in VAN HOFF and YAHOO set forth above with respect to claim 25. Therefore, claims 33-36 are patentable over VAN HOFF, YAHOO, and LAZARUS et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 25.

In view of the foregoing amendment and remarks, Applicants respectfully request the Examiner's reconsideration of the application and the timely allowance of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

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